

**REMARKS**

I. **Status of the Claims**

Claims 1-97 are pending. Claims 1, 35, 72, 89, and 90 have been amended by this response to more particularly point out and distinctly claim the subject matter Applicants regard as their invention. Support for the amendment can be found throughout the specification as originally filed. Specifically, support for at least one texturizing agent wherein the total amount of all texturizing agents present in the composition is less than or equal to 10% by weight, relative to the total weight of the composition can be found in the specification at page 2, paragraph [0036].

Claims 36 and 82 are cancelled as their limitations are now incorporated into Claims 35 and 82, respectively. Additionally, claims 35 and 80 have been amended to include the limitations of claims 36 and 82, respectively, which the Examiner has indicated are allowable if rewritten in independent form including all the limitations of the base claim. See Final Office Action at page 7. Claim 37 has been amended to depend on claim 35, as opposed to cancelled claim 36.

Claims 89 and 94 have been amended by this response to more particularly point out and distinctly claim the subject matter Applicants regard as their invention. Support for the amendment can be found throughout the specification as originally filed. Specifically, support for the composition being capable of forming a film for which the wear resistance is greater than 10% by weight, relative to the total weight of the composition can be found in the specification at page 2, paragraph [0029].

Claims 9, 12, 26 and 87 have been amended by this response to more particularly point out and distinctly claim the subject matter Applicants regard as their

invention. In addition, claims 9, 12, 26 and 87 have been amended to reflect a proper alternative format and to clarify the language of the claims.

Finally, Applicants have cancelled claim 71.

**II. Rejection Under 35 U.S.C. § 112**

The Examiner has rejected claims 9-14, 26-29 and 87 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Final Office Action at page 2.

The Examiner asserts that alternative expressions must be drafted in proper alternative format, such as "selected from A, B, or C" or in proper Markush format, i.e., "selected from the group consisting of A, B, and C." *Id.* The Examiner asserts that because the present claims are not drafted in one of those two formats, that what is meant to be encompassed by the claims is unclear. *Id.* The Examiner notes that though "chosen from" may be an acceptable alternative format, instant claims 9, 12, and 26 do not recite this phrase. *Id.* Applicants respectfully submit that in view of the Applicants amendments, claims 9, 12, 26 and 87 are in proper alternative language and provide no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. For these reasons, Applicants request that the rejection be withdrawn.

**III. Claim Rejections under 35 U.S.C. § 102**

**A. Leacock**

The Examiner has rejected claims 1-18, 21-34, 86, and 93 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2003/0175225 to Leacock et al. ("Leacock"). Final Office Action at page 2. According to the Examiner, Leacock teaches a nail polish composition comprising aluminum platelets, silicon dioxide plates coated with a metal oxide, at least one organic solvent, at least one film-forming substance, at least one plasticizer, at least one suspending agent, and at least one adhesion promoter. See Final Office Action at page 3. The Examiner alleges that Leacock teaches that the film-forming component "is generally provided in an amount from about 5 to 40wt% of the total weight of the composition." *Id.* Therefore, the Examiner concludes Leacock teach nail enamel formulations that read upon the instantly claimed components and ranges. *Id.* Applicants respectfully disagree and traverse this rejection for at least the following reasons.

To anticipate a claim under 35 U.S.C. § 102, the reference must teach each and every element recited in the claims, and the identical invention must be shown in as complete detail as in the claims. See *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d at 1053; *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d at 1920. Applicants submit that Leacock does not teach each and every element recited in the claims as amended.

In particular, Applicants have amended claims 1, 35, 72, 89, and 90 to recite "at least one texturizing agent wherein the total amount of all texturizing agents present in the composition is less than or equal to 10%." See Claim 1. Leacock teaches a

composition comprising a film-forming agent and a plasticizer in amounts ranging from 5.0 to 40 wt% and from 0.1 to 15.0 wt%, respectively, based on the total weight of the composition. Leacock at par. [0019]-[0020]. However, Leacock is silent with respect to the total amount of the texturizing agent and does not suggest that the total amount of such ingredients must be less than or equal to 10% as taught in Applicants' disclosure. Furthermore, none of the examples in Leacock disclose a composition where the total amount of all texturizing agents is less than or equal to 10% by weight. Accordingly, for this reason alone Applicants respectfully request the reconsideration and withdrawal of the rejection.

Additionally, Leacock fails to teach or suggest yet another limitation in the Applicants' disclosure. Claim 1, for example, teaches a composition comprising at least one particle with a metallic glint present in an amount greater than or equal to 2% by weight, relative to the total weight of the composition. On the other hand, Leacock discloses a nail enamel composition comprising silicon dioxide platelets, coated with synthetically produced pigments, and aluminum platelets, which produce a color shift over a metallic or chrome-like background. Leacock at par. [0016]. As stated in paragraph [0100] of the Applicants' disclosure, the particles with a metallic glint reflect incident light to achieve a mirror effect as opposed to Leacock which requires a metallic or chrome-like background to achieve a color shift. Thus, Leacock does not teach at least one particle with a metallic glint as defined by the instant invention. Furthermore, each example disclosed in Leacock uses an aluminum powder in an amount less than 2% by weight, relative to the total weight of the composition, contrary to the Applicants' claims. Because Leacock achieves a color shift by using a chrome like background, as

opposed to a particle with a metallic glint, and uses aluminum power in an amount less than 2% by weight, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**B. U.S. Patent No. 6,296,839**

The Examiner has rejected claims 1-16, 21-34, 71-78, 88, 90-93, and 95-97 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,296,839 to Ramin et al. ("Ramin '839"). Final Office Action at page 4. According to the Examiner, Ramin '839 teaches a nail varnish kit comprising a first composition containing at least one film-forming polymer and a second composition comprising, in an organic solvent, at least one film-forming polymer, at least one metal pigment, at least one organopolysiloxane, and at least one pyrogenic silica. *Id.* The Examiner asserts that the film-forming polymer "preferably comprises a mixture of 0.05% to 30wt% nitrocellulose and 0.05 to 30wt% cellulose ester of the base and/or surface compositions." *Id.* The Examiner further asserts that the composition of Ramin '839 may also contain clay, plasticizing agents, and commonly used additives including thickening agents. *Id.* at 5. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

Under 35 U.S.C. § 102, a reference must teach each and every element recited in the claim to anticipate that claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

As explained above, Applicants have amended claims 1, 35, 72, 89, and 90 to recite “at least one texturizing agent wherein the total amount of all texturizing agents present in the composition is less than or equal to 10%”. See Claim 1. Ramin '839 discloses a composition that comprises from 1% to 60% by weight of the film-forming polymer. Ramin '839 at col. 5, lines 14-19. However, as with Leacock, Ramin '839 fails to teach that the total amount of all texturizing agents must be less than or equal to 10%. For instance, Example 1 of Ramin '839 uses plasticizers (6 wt%) and various film forming agents (5 wt% of nitrocellulose, 9 wt% of alkyd resins, 0.5wt% of cellulose acetobutyrate, 0.3wt% of polydimethylsiloxane) suggesting a total amount of texturizing agents greater than 10%. Accordingly, Ramin '839 does not teach or suggest the limitation of Applicants' claims as amended and Applicants respectfully request the reconsideration and withdrawal of the rejection.

**C. U.S. Patent No. 6,491,932**

The Examiner has rejected claims 1-35, 38-71, 88-90, and 93-95 under 35 U.S.C. §§ 102(a) and (e) as allegedly anticipated by U.S. Patent No. 6,491,932 to Ramin et al. ("Ramin '932"). Final Office Action at page 5. According to the Examiner, Ramin '932 teaches a cosmetic nail varnish composition comprising glass particles coated with at least one metallic coat and at least one film-forming polymer in an amount ranging from 1 to 70% by weight of the total composition. Final Office Action at 5. The Examiner asserts that Ramin '932 teaches specific examples that read upon the instantly claimed compositions. *Id.* at 6.

To anticipate a claim, the reference must teach each and every element recited in the claims, and the identical invention must be shown in as complete detail as in the

claims. *See Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d at 1053; *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d at 1920. In addition, when a reference does not teach specific examples within the claimed range, the reference must disclose the claimed subject matter with sufficient specificity to anticipate the claims. *See* M.P.E.P. § 2131.03. Applicants respectfully submit that Ramin '932 does not teach the claimed ranges with sufficient specificity to anticipate the claims, and further, that Ramin '932 does not teach all of the elements recited in the presently amended claims. Therefore, Applicants respectfully traverse the rejection for at least the following reasons.

As explained previously, Applicants claims as amended require at least one texturizing agent wherein the total amount of all texturizing agents present in the composition is less than or equal to 10% by weight, relative to the total weight of the composition. However, the total amount of texturizing agents disclosed in Ramin '932 is great than 10%. More specifically, according to Ramin '932, the film-forming polymers are present in the composition in an amount ranging from 1% to 70% by weight relative to the total weight of the composition. *See* Ramin '932 at col. 5, lines 6-9. The composition of Ramin '932 also may contain other texturizing agents, such as plasticizers and resins. *See id.* at col. 5, line 48 to col. 6, line 60. In particular, every example taught in Ramin '932 comprises film-forming polymers, plasticizers and resins--all of which are texturizing agents in an amount greater than 10% of the total weight of the composition. Therefore, Ramin '932 cannot anticipate the Applicants' presently amended claims with sufficient specificity as required under 35 U.S.C. §102.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

**IV. Rejections Under 35 U.S.C. § 103**

**A. Leacock**

The Examiner has rejected claims 19, 20, 35-85, 87-92, and 94-97 under 35 U.S.C. § 103(a) as allegedly unpatentable over Leacock. Final Office Action at page 6. Applicants respectfully disagree for the reasons stated below.

**1. Wear Resistance**

The Examiner acknowledges that Leacock does not teach the wear resistance as recited in independent claims 35, 80, 89, and 94. Office Action dated 3/3/06 at 6. Furthermore, the Examiner asserts that one of ordinary skill in the art would have been motivated to utilize routine experimentation to determine the optimum content of the components taught by Leacock et al to provide the desired wear resistance for a particular end use. *Id.*

In order to advance prosecution, the Applicants have amended claims 35, 80, 89 and 94 to include the limitations of wear resistance which is greater than 10% by weight relative to the total weight of the composition. The Examiner has stated claims 36, 37, and 82 contains allowable subject matter and would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. Final Office Action at page 7. Therefore, in view of these amendments, Applicants respectfully request withdrawal of the rejection.

## **2. Shape Factor**

Although the Examiner acknowledges that Leacock fails to teach the claimed shape factor, she asserts that "platelets utilized in the art typically have a shape factor within the instantly claimed range and it would have been obvious to one having ordinary skill in the art to select a particular shape factor based on the desired aesthetic properties of the final coating." Office Action dated 3/3/06 at page 7. Applicants disagree.

The Examiner has a duty to make explicit factual findings as evidence of a motivation for making a claimed invention. *See In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Indeed, these factual findings must be "clear and particular." *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Examiner's sole support for the teaching of the shape factor as instantly claimed is that "platelets utilized in the art typically have a shape factor within the instantly claimed range and it would have been obvious to one having ordinary skill in the art to select a particular shape factor based on the desired aesthetic properties of the final coating" Office Action dated 3/3/06 at page 7. This statement is conclusory in light of the much more general teachings of the prior art, from which the Examiner carves out particular combinations in an attempt to obtain the claimed invention. Because the Examiner has failed to identify prior art suggesting all the claim limitations, she has not established a *prima facie* obviousness. Applicants respectfully request reconsideration and withdrawal of the rejection.

## **3. Coated Silicon Dioxide Particles**

The Examiner asserts that one of ordinary skill in the art "would have been motivated to include or delete these coated silicone oxide particles based on the desired coloring and aesthetic properties of the final coating." Office Action dated 3/306 at page 7. However, the Examiner acknowledges that Leacock incorporates coated silicon oxide particles, contrary to some of the [Applicants'] instant claims. *Id.* More specifically, Applicants' claims state that the composition does not contain silicon dioxide particles coated with a metal or a metal oxide, as required by Leacock. See claims 71 and 95.

Applicants disagree with the Examiner's reasoning. The Examiners proposed modification would render the invention of Leacock unsatisfactory for its intended use. When evaluating claims for obviousness under 35 U.S.C. 103, M.P.E.P. § 2143.03 directs the examiner to consider all the limitations of the claims, including negative limitations which expressly excluded, i.e., silicon dioxide particles. The Examiner has pointed to nothing in the art to support the deletion of silicon dioxide particles from the composition as claimed. More specifically, Leacock uses the silicone dioxide platelets coated with a metal oxide to provide a unique color change effect on a metallic or mirror-like background. See Leacock at par. [0025]. Yet, the Examiner insists that one of ordinary skill in the art would have been motivated to remove the silicon dioxide particles when Leacock clearly teaches their necessity for the color changing effect. There is simply no guidance in the prior art for these teachings and Applicants respectfully request withdrawal of this rejection.

#### **4. Multi-compartment Kit**

Finally, with respect to Leacock, the Examiner states that "it is well established in the art that nail color compositions as taught by Leacock et al, are *commonly provided* commercially with a second composition comprising a film-forming polymer as instantly claimed to serve as a base coat or top clear coat in making up nails and would have been obvious to one skilled in the art at the time of the invention. (Emphasis added)." Office Action dated 3/3/06 at page 7. Yet, the Examiner admits that Leacock does not specifically teach the instantly claimed multi-compartment kit with a second film forming nail varnish composition.

The Examiner cannot shirk the burden to establish a *prima facie* case of obviousness by making a rejection without meeting the requirements set forth by U.S. case law and the M.P.E.P. The use of the phrase "commonly provided" is not sufficient to avoid the burden of making a *prima facie* case obviousness rejection because the cited prior art does not teach all of the elements recited in the present claims. M.P.E.P. § 2144.03 advises the Examiner against relying solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. Because the Examiner has failed to provide any support for her rejection, Applicants respectfully request withdrawal of this rejection.

#### **B. U.S. Patent No. 6,296,839**

The Examiner has rejected claims 17-20, 35-70, 80-87, 89, and 94 under 35 U.S.C. § 103(a) as allegedly unpatentable over Ramin '839. Final Office Action at page

6. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

**1. Wear Resistance**

As explained above, in order to advance prosecution, the Applicants have amended claims 35, 80, 89 and 94 to include the limitations of wear resistance which is greater than 10% by weight relative to the total weight of the composition. Therefore, in view of these amendments, Applicants respectfully request withdrawal of the rejection.

**2. Particle Shape**

The Examiner acknowledges that Ramin '839 fails to teach the claimed particle shape and shape factor. Office Action dated 3/3/3006 at 7. Although Ramin '839 is silent, the Examiner alleges that flat or platelet metal pigments are *conventional in the art* and would have been obvious to one skilled in the art at the time of the invention, wherein one could determine the optimum shape factor to provide the desired aesthetic properties for a particular end use *Id.* Applicants respectfully disagree.

As explained previously, it is never appropriate to rely solely on "conventional" knowledge in the art without evidentiary support in the record. M.P.E.P § 2144.03. The Examiner has not provided any evidence of a teaching or suggestion to modify the particles of Ramin '839 to use flat or platelet metal particles or to use the claimed shape factor. And the Examiner has not provided any evidence that shows that flat or platelet metal pigments are conventional in the art. Even if, the modification is within the capabilities of one skilled in the art, this standards is insufficient on its own to create a *prima facie* case of obviousness. See M.P.E.P. § 2143.01.

Therefore, Applicants respectfully request the reconsideration and withdrawal of the rejection.

### **3. Composition Ranges**

Lastly, with respect to Ramin '839, the Examiner asserts that routine experimentation would determine the optimum composition for each coating layer to provide the desired aesthetic and wear resistance properties for the finished colored nails. Office Action dated 3/3/06 at page 8. Applicants disagree.

To establish a *prima facie* case of obviousness, three criteria must be met: there must be some suggestion or motivation to modify the reference teaching; there must be a reasonable expectation of success; and the reference must teach or suggest all the claim limitations. M.P.E.P. § 2143. The Examiner acknowledges that Ramin '839 does not teach all of the claim elements. Office Action dated 3/3/06 at 7. The Examiner has failed to point to a teaching or suggestion to modify the prior art, therefore one skilled in the art would not have been motivated to modify the composition ranges disclosed in Ramin et al. as asserted by the Examiner.

Simply stated, the Examiner has failed to meet the three criteria stated in M.P.E.P. § 2143 to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

### **C. U.S. Patent No. 6,491,932**

The Examiner has rejected claims 36, 37, 72-87, 91, 92, 96, and 97 under 35 U.S.C. § 103(a) as allegedly unpatentable over Ramin '932. Final Office Action at page

6. Applicants respectfully disagree and traverse the rejection for at least the following reasons.

**1. Wear Resistance**

As explained previously, in order to advance prosecution, the Applicants have amended claims 35, 80, 89 and 94 to include the limitations of wear resistance which is greater than 10% by weight relative to the total weight of the composition. Therefore, in view of these amendments, Applicants respectfully request withdrawal of the rejection.

**2. Multi-Compartment Kit**

The Examiner alleges that it would have been obvious to one skilled in the art to provide the second composition comprising a film-forming polymer as claimed because it is **well established** in the art that nail color compositions as taught by Ramin et al '932, are **commonly provided** commercially with a second composition comprising a film-forming polymer as instantly claimed in the Applicants invention. Office Action dated 3/3/06 at page 8. The Examiner appreciates that Ramin '932 does not teach a multi-compartment kit comprising a second composition as recited in independent claims 72, 80, 91, 92, and 96, yet she maintains her position that a multi-compartment kit would have been obvious given the art. See Final Office Action at pages 6-7. Applicants respectfully disagree and traverse this rejection.

As explained previously, it is the Examiner's burden to provide support for a statement that something is "commonly provided" or "well established" in the art. See M.P.E.P. § 2144.03. Ramin '932 does not teach or suggest the multi-compartment kit comprising the second composition as claimed, therefore one skilled in the art would not

have been motivated to modify the composition of Ramin '932 as asserted by the Examiner. M.P.E.P. § 2144.03 prohibits the Examiner from relying solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. Because the Examiner has provided no support for a teaching in the prior art to use a multi-compartment kit comprising a second composition comprising at least one film-forming agent in an amount of at least 10% by weight relative to the weight of the second composition, the Applicants respectfully request the reconsideration and withdrawal of the rejection.

**V. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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